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OFFICE OF PETITIONS

In re Application of	:
Roschke et al.	: DECISION ON APPLICATION
Application No. 10/067,800	: FOR
Filed: 8 February, 2002	: PATENT TERM ADJUSTMENT
Atty. Dkt. No.	:
1488.11500011/EKS/HCC	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 CFR 1.705(b)," filed 11 April, 2006, requesting that the Office reconsider the determination of Patent Term Adjustment (PTA) that accompanied the Notice of Allowance. Applicants request that the initial determination of patent term adjustment be corrected from five hundred three (503) days to five hundred thirty-one (531) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is five hundred thirty-one (531) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

BACKGROUND

On 12 January, 2006, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants was advised that the patent term

adjustment to date was 503 days. The period of adjustment of 546 days was reduced by 43 days for applicant delay.

In response, applicants timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 CFR 1.18(e). Applicants request that the patent term adjustment be corrected to 531 days. The basis for this correction is 37 CFR 1.702(a)(1). Applicants contend that the patent term should be adjusted because the application was filed 8 February, 2002, and the first notification received by the Applicant, an Office action mailed by the USPTO on 5 October, 2004, fourteen months and 546 days after the application filing date, was vacated as a result of Office error. Subsequently, the Office action mailed on 5 October, 2004, was vacated, and a new Office action mailed on 2 November, 2004, setting a new time period for reply, the new Office action having been mailed fourteen months and 574 days after the application filing date.

Applicants further state that the patent issuing from the application is not subject to a terminal disclaimer and that there were no circumstances in the prosecution of the application which constituted failure to engage in reasonable efforts to conclude processing or examination.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

– Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to–

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after–

(i) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

37 CFR § 1.702 provides that:

(a) Failure to take certain actions within specified time frames . Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

OPINION

Applicants' arguments and evidence have been considered, in light of the application history, and it has been determined that the initial period of adjustment pursuant to § 1.702(a)(1) should be adjusted because a review of the record reveals that the Office action mailed on 5 October, 2004, omitted page 1. Therefore, the Office action mailed on 5 October, 2004, was incomplete. As such, the Office did not mail a proper first notification under 132 on 5 October, 2004.

Thus, it is concluded that, in this instance, the remailing of the action under 35 U.S.C. 132 did constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

In view thereof, applicants received a complete and proper restriction requirement on 2 November, 2004, rather than 5 October, 2004. As the Office action mailed on 2 November, 2004, was mailed fourteen months and 574 days after the filing of the application on 8 February, 2002, applicant's request for adjustment of the patent term by 28 days is granted.

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is five hundred thirty-one (531) days.

CONCLUSION

In view thereof, the petition is GRANTED.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publications for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" written in a larger, more prominent script than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

PALM INTRANET

Time: 18:18:42

PTA Calculations for Application: 10/067800

Application Filing Date:	02/08/2002	PTO Delay (PTO):	546
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	43
Post-Issue Petitions:	0	Total PTA (days):	531
PTO Delay Adjustment:	28		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
69	06/15/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		546	
68	06/15/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	574		
51	01/12/2006	MAIL NOTICE OF ALLOWANCE			
50	01/12/2006	MAIL FORMAL DRAWINGS REQUIRED			
49	01/09/2006	ISSUE REVISION COMPLETED			
48	01/09/2006	FORMAL DRAWINGS REQUIRED			
47	01/09/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
46	01/09/2006	CASE DOCKETED TO EXAMINER IN GAU			
45	01/09/2006	NOTICE OF ALLOWABILITY			
44	12/10/2005	DATE FORWARDED TO EXAMINER			
43	12/05/2005	AMENDMENT AFTER FINAL REJECTION			
42	10/05/2005	MAIL FINAL REJECTION (PTOL - 326)			
41	10/03/2005	FINAL REJECTION			
40	07/11/2005	DATE FORWARDED TO EXAMINER			
39	06/30/2005	RESPONSE AFTER NON-FINAL ACTION			
38	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
37	06/01/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	04/05/2005	MAIL NON-FINAL REJECTION			
35	04/04/2005	NON-FINAL REJECTION			
34	02/15/2005	REFERENCE CAPTURE ON IDS			
33	02/15/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		43	29
32	01/14/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	01/03/2005	PRELIMINARY AMENDMENT			

30	01/14/2005	DATE FORWARDED TO EXAMINER			
29	01/03/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
28	01/03/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	01/03/2005	WORKFLOW INCOMING AMENDMENT IFW			
26	11/02/2004	MAIL NOTICE OF WITHDRAWN ACTION			
25	11/02/2004	MAIL RESTRICTION REQUIREMENT			
24	11/01/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
23	11/01/2004	LETTER WITHDRAWING / VACATING OFFICE ACTION			
22	10/05/2004	MAIL RESTRICTION REQUIREMENT	546		-1
21	10/01/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
20	08/25/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	08/12/2004	REFERENCE CAPTURE ON IDS			
18	08/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	07/27/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	04/06/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	07/24/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	07/08/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
13	09/10/2002	CASE DOCKETED TO EXAMINER IN GAU			
12	08/19/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	06/25/2002	APPLICATION DISPATCHED FROM OIPE			
10	06/11/2002	APPLICATION IS NOW COMPLETE			
9	06/03/2002	ADDITIONAL APPLICATION FILING FEES			
8	06/03/2002	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
7	04/01/2002	CORRECTED PAPER			
5	03/06/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
4	02/20/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	02/08/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
2	02/08/2002	INITIAL EXAM TEAM NN			

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